

Application No. 09/890,076

Docket No. 3COM 2257-2

REMARKS

In the Official Action mailed 22 December 2005, the Examiner reviewed claims 22 and 25-45. The Examiner rejected claims 39-45 under 35 U.S.C. 112; rejected claims 22, 25, 28-30, 35, 39, 42 and 45 under 35 U.S.C. 102(e); rejected claims 22, 25, 27, 31, 35 and 37 under 35 U.S.C. 103(a); rejected claims 26, 28-30, 32-34 and 38 under 35 U.S.C. 103(a); rejected Claim 36 under 35 U.S.C. §103(a); rejected claims 39, 42, 44 and 45 under 35 U.S.C. 103(a); rejected claims 40 and 41 under 35 U.S.C. 103(a); rejected claim 43 under 35 U.S.C. 103(a).

Claim 39 is amended. Claims 46-60 are new. Claims 22 and 25-60 remain pending.

The Examiner's rejections are respectfully traversed below.

Rejection of Claims 39-45 under 35 U.S.C. §112

The Examiner rejected claims 39-45 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant amends claim 39 to address the informality. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 22, 25, 28-30, 35, 39, 42 and 45 under 35 U.S.C. §102(e)

The Examiner rejected claims 22, 25, 28-30, 35, 39, 42 and 45 under 35 U.S.C. §102(e) as being anticipated by Beck et al. (USP 6,604,140).

Beck et al. (USP 6,604,140) is not prior art. Beck et al. (USP 6,604,140) claims the benefit of Beck et al. (60/127,225) filed 31 Mar 1999. The present application is a continuing application of USP 6,216,158 filed 25 Jan 1999.

Accordingly, the rejection is moot.

Rejection of Claims 22, 25, 27, 31, 35 and 37 under 35 U.S.C. §103(a)

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The Examiner rejected claims 22, 25, 27, 31, 35 and 37 under 35 U.S.C. §103(a) as being unpatentable over Ortony (USP 6,038,595), Orenshteyn (USP 5,889,942), Frese, II et al (USP 5,909,545).

Claim 22 includes at least the following limitation not disclosed by the cited combination:

“wherein the protocol includes one or more exchanges ... by which the console application learns the network addresses of services in the group”

Ortony does not disclose the above limitation. The primary reference Ortony teaches away from learning new network addresses as claimed. Ortony teaches the storage and use of pre-selected addresses of network servers. column 2, line 56 to column 3, line 2. Modifying Ortony with Orenshteyn would destroy a purpose of Ortony to limit the availability of adult-oriented services from children, and to simplify the device by allowing access to a limited number of services accessible via a simple channel control. column 8, lines 29-56. The Examiner noted on page 3 of the Office Action mailed 22 December 2005 that such a teaching away in the primary reference is of particularly importance in the impropriety of an obviousness rejection.

Accordingly, the cited combination does not make unpatentable claim 22 and dependent claims 27, 31, 35 and 37. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 26, 28-30, 32-34 and 38 under 35 U.S.C. §103(a)

The Examiner rejected claims 26, 28-30, 32-34 and 38 under 35 U.S.C. §103(a) as being unpatentable over Ortony, Orenshteyn and Frese.

Claim 22 includes at least the following limitation not disclosed by the cited combination:

“wherein the protocol includes one or more exchanges ... by which the console application learns the network addresses of services in the group”

The cited combination is improper because Ortony prefers a pre-selected addresses to be stored on the device, and teaches away from the learning of new

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addresses. Therefore, the cited combination does not make unpatentable dependent claims 26, 28-30, 32-34 and 38. Withdrawal of the rejection is respectfully requested.

Rejection of Claim 36 under 35 U.S.C. §103(a)

The Examiner rejected claim 36 under 35 U.S.C. §103(a) as being unpatentable over Ortony, Orenshteyn and Frese, in further view of Whitchead et al., (USP 6,085,030).

Claim 22 includes at least the following limitation not disclosed by the cited combination:

“wherein the protocol includes one or more exchanges ... by which the console application learns the network addresses of services in the group”

The cited combination is improper because Ortony prefers a pre-selected addresses to be stored on the device, and teaches away from the learning of new addresses. Therefore, the cited combination does not make unpatentable dependent claim 36. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 39, 42, 44 and 45 under 35 U.S.C. §103(a)

The Examiner rejected claims 39, 42, 44 and 45 under 35 U.S.C. §103(a) as being unpatentable over Frese, in view further view of Orenshteyn.

The Examiner's rejection lacks a proper motivation to combine. The motivation to combine must come from the prior art, and not from hindsight.

The Examiner's stated motivation to combining Frese with Orenshteyn is “It would have been obvious to one of ordinary skill in the art to implement Orenshteyn's address discovery method into Frese's data processing tool enabling the user to dynamically discover the services provided within his local area network”. The Examiner has not disclosed where the prior art discloses this motivation. Applicant challenges this stated motivation as an unsupported conclusory statement, and to maintain the rejection, the Examiner support this conclusory statement, as required by MPEP 2144.03 section C (“If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence”).

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Rejection of Claims 40 and 41 under 35 U.S.C. §103(a)

The Examiner rejected claims 40 and 41 under 35 U.S.C. §103(a) as being unpatentable over Frese and Ortony, in further view of Myers, et al.

Claim 39, from which claims 40 and 41 depend, includes at least the following limitation not disclosed by the combination:

“establishing a communication link via the network between the portable computing platform and the particular processor by which the portable computing platform learns network addresses of services in the group”

Because the cited combination does not disclose the learning of new work addresses of services as claimed, the cited combination does not make unpatentable dependent claims 40 and 41. Withdrawal of the rejection is respectfully requested.

Rejection of Claim 43 under 35 U.S.C. 103(a)

The Examiner rejected claim 43 under 35 U.S.C. 103(a) as being unpatentable over Frese and Ortony, in further view of Whitehead.

Claim 39, from which claim 43 depends, includes at least the following limitation not disclosed by the combination:

“establishing a communication link via the network between the portable computing platform and the particular processor by which the portable computing platform learns network addresses of services in the group”

Because the cited combination does not disclose the learning of new work addresses of services as claimed, the cited combination does not make unpatentable dependent claim 43. Withdrawal of the rejection is respectfully requested.

New Claims 46-60

New claim 46 has the following differences in claim limitation from current claim 22. Claim 46 has the limitation “the particular service in the group of services sends the console application a set of user interface constructs for incorporation in the user

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interface program". Claim 46 does not have the limitation "by which the console application learns the network addresses of services in the group".

Neither Ortony nor Orenshteyn discloses the service sending a console application user interface constructs. Ortony already stores a dedicated web browser and email program. column 6, lines 30-40 and 62-65. In Orenshteyn, the application running on a remote server relies on a quasi-OS on the client to generate user interface constructs. column 7, lines 55-65.

Accordingly, new claim 46 and dependent claims 47-60 are patentable.


CONCLUSION

It is respectfully submitted that this application is now in condition for allowance, and such action is requested.

The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (3COM 2257-2).

Respectfully submitted,

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